

Application No. 10/062,798
Amendment dated February 23, 2006
Reply to Office Action mailed October 7, 2005

REMARKS

I. Interview Summary

Applicants and their attorney first wish to thank the Examiner for the telephonic interview of February 7, 2006 (the "Interview"), during which the multiplicity rejection contained within the First Office Action was discussed. The Interview was between the Examiner and Applicants and was the first telephonic communication with the Examiner concerning the issue of undue multiplicity.

During the Interview, counsel pointed out that the multiplicity rejection mentions twenty-five (25) claims in a parenthetical and inquired as to whether the First Office Action specifies a requirement of no more than twenty-five claims or whether the First Office Action merely suggests twenty-five claims. Counsel also inquired as to whether a written reply to the First Office Action having fifty-five (55) claims would be responsive to the First Office Action. In response to these inquiries of counsel, the Examiner stated that the First Office Action does not specify a requirement of twenty-five claims and that a written reply to the First Office Action having fifty-five claims would be responsive to the First Office Action.

II. Status of the Claims

One hundred thirty-eight (138) claims had been pending in the application. By the foregoing amendments, Applicants have now cancelled the following eighty-three (83) claims: Claims 47, 51-54, 56, 61, 64, 66-77, 79-91, 96, 100, 105, 107-109, 115, 118,

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121-127, 129-145, 150, 155-158, 164, 168, 173, 175, 177-182, and 184-186.¹ Applicants hereby reserve the right to pursue any and all of the cancelled claims in this application and/or another application (e.g., a continuation application).²

Fifty-five (55) claims remain pending in the application after the cancellation of the eighty-three claims identified above. These fifty-five claims include the following seven (7) independent claims and forty-eight (48) dependent claims:

- (1) Independent Claim 1
and Claims 44-46, 48-50, and 55 depending therefrom
- (2) Independent Claim 57
and Claims 58-60, 62-63, and 65 depending therefrom
- (3) Independent Claim 92
and Claims 93-95 and 97-99 depending therefrom
- (4) Independent Claim 101
and Claims 102-104, 106, 110, and 183 depending therefrom
- (5) Independent Claim 111
and Claims 112-114, 116-117, and 120 depending therefrom
- (6) Independent Claim 146
and Claims 147-149 and 151-153 depending therefrom
- (7) Independent Claim 159
and Claims 160-163, 165-167, and 169-172 depending therefrom

¹ Claims 2-43, 78, 119, 128, 154, 174, and 176 have been cancelled by prior amendment.

² The cancellation of claims shall not be construed as a waiver of any provisional rights and/or as a surrender of any equivalent subject-matter under the Doctrine of Equivalents.

III. Comments Concerning the Undue Multiplicity Rejection

In the First Office Action, the Examiner rejected all then-pending claims under 35 U.S.C. § 112 ¶ 2 on the grounds of alleged undue multiplicity. Applicants respectfully traverse the multiplicity rejection, request reconsideration and withdrawal of same, and, at least for the reasons discussed below, request examination of all one-hundred thirty-eight claims pending prior to entry of the present amendment.

The standard for evaluating the issue of undue multiplicity requires that the Examiner consider whether the number of claims is reasonable in view of all of the relevant facts and circumstances. As stated by the Court of Customs and Patent Appeals, “[a]pplicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed” and “the right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged.” M.P.E.P § 2173.05(n) (internal citations omitted). In evaluating the propriety of an undue multiplicity rejection, a “*rule of reason should be practiced and applied on the basis of the relevant facts and circumstances in each individual case.*” Id. (italics added). Any undue multiplicity rejection should be judiciously applied and “*rare.*” See id.

Applicants respectfully submit that, under the relevant facts and circumstances, the claims are not multiplicative and the total number thereof are not undue. This is demonstrated by Applicants’ Petition for Special Status of July 2003, which was granted in March 2004. The first page of the Petition clearly indicates that there was an actual infringement, that the infringers were planning to commit other infringing acts in

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February 2004 and in subsequent years, and that Applicants served notice to the infringers prior to the infringement to accrue provisional rights. See 35 U.S.C. § 154(d). Applicants believe that acts of infringement have been committed in 2004, 2005, and 2006.

In view of the above, to any extent the number of claims may be deemed multiplicative, which is a point not conceded by Applicants, it is respectfully submitted that such multiplicity cannot be considered as being "*undue*" in view of the relevant facts and circumstances. Applicants have invested substantial resources in drafting the patent claims and, further to the provisional rights of 35 U.S.C. § 154(d) referenced in the Petition, Applicants have had the present application republished twice and have served notice twice to the above-referenced infringers. In response to Applicants' Petition, the U.S. Patent and Trademark Office (USPTO) granted special status to the examination of the claims. In addition, the USPTO accepted Applicants' payment of substantial additional claim fees for the purpose of such examination.

For at least the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the multiplicity rejection and examination of all those one hundred thirty-eight (138) claims pending prior to entry of the present amendment. If, after reviewing Applicants' request for reconsideration, the Examiner determines not to withdraw such multiplicity rejection, Applicants respectfully request that the Examiner examine those fifty-five (55) claims that remain pending after entry of the present amendment.

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Should there remain any questions or other matters whose resolution could be advanced by a telephone call, the Examiner is invited to contact the undersigned attorney at his number below. For the sake of good order, it is noted that a Power of Attorney and Statement Under 37 C.F.R. § 3.73(b) authorizing the undersigned attorney to act on behalf of Applicants are submitted concurrently herewith. An appropriate Extension Petition is also submitted herewith. The Examiner is authorized to charge any deficiency and/or credit any overpayment to Deposit Account 503571.

Respectfully submitted,

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